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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,905	03/22/2004	Shawn T. Rodeback	3016.2.5	9677

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EXAMINER	
CARRILLO, BIBI SHARIDAN	
ART UNIT	**PAPER NUMBER**
1746	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

Office Action Summary	Application No.	Applicant(s)	
	10/805,905	RODEBACK ET AL.	
	Examiner	Art Unit	
	Sharidan Carrillo	1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *1-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *03/22/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, drawn to a device, classified in class 15, subclass 320.

II. Claims 13-20, drawn to a method, classified in class 134, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as polishing of a floor.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Starkweather on 7/26/04 a provisional election was made with traverse to prosecute the invention of Group II, claims 13-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The limitations of a) lacquered based paints/polishes instead of residue, b) cleaning of textiles, c) cleaning with solvent vapors, where the absorbent pad prevents solvent from contacting directly with the carpet, and d) a vapor transfer box comprising an absorbent pad and a vapor transfer chamber are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Additionally, the claims require an absorbent pad in addition to the vapor transfer chamber in order to perform the given method of applying of solvent to the absorbent pad, generating solvent vapors and contacting the pad and the vapors with the surface of the textile in order to remove the residue.

8. Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for lacquered based polishes/paints and textiles, does not reasonably provide enablement for any residue and cleaning of any surface. The specification does not enable any person skilled in the art to which it pertains, or

with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claims embrace an invention which contains any known residue and surface to be cleaned, which could/ can be selected from literally thousands. It does not appear to be feasible that any surface or residue would function in the present invention. Further, for one skilled in the art to reproduce the present invention (which must be possible, if the specification is adequate), there would clearly be undue experimentation in an attempt to figure out which residues and surfaces would work and which ones would not. Therefore, the claims should be amended to recited lacquered based polishes/paints and textile surfaces.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and19 are indefinite because it is unclear whether applicant intends cleaning of any surface or cleaning of textiles. Claims13 and 19 are indefinite because the preamble fails to recite removing residue from a textile surface. Claim 13 and 19 are indefinite because it is unclear how the residue is removed. There is no step of contacting the pad containing the solvent vapor with the textile surface. Claim 19 is further indefinite because there is no positive step of removing the residue. Claim 14 is indefinite because it is unclear whether the solvent applying step occurs after the

housing device is removed from the surface. Claim 15 is indefinite because claim 13 fails to recite the generation of solvent vapors or any mention of a solvent. Claim 15 is further indefinite because it is unclear the structural relationship between the housing device, the absorbent pad, and the solvent vapor chamber. Claims 17-18 are indefinite because they are dependent on claim 11 and not 13. Claims 17-18 are further indefinite since there is not recitation of solvent in claim 13 or any steps directed to the removal of solvent.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodford (4353145).

Woodford teaches a method for cleaning rugs by applying a solvent to the absorbent pad 28 within the housing device 12, placing the device above the surface of the carpet an removing the device after the residue has softened, the softening inherently resulting from scrubbing the carpet with scrubber pads in combination with the addition of cleaning solution. In reference to claims 14 and 17, refer to elements 40 and 84 and the abstract. In reference to claim 15 and in view of the indefiniteness, the limitations are met by Woodford since Woodford teaches using the apparatus for steam cleaning, the limitations of which read on "solvent vapors". In reference to claim 16 and

in view of the indefiniteness, the limitations are met since Woodford teaches steam cleaning and evacuating via element 82. In reference to claim 18, the limitations are inherently met by scrubbing with a scrubber pad.

13. Claims 13-14 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson et al. (6260232).

Nelson et al. teach cleaning a surface by applying a solvent to the absorbent pad 536 within a device housing 513 (Fig. 16), placing the housing device 513 over the surface to be cleaned and removing the housing from the surface. The limitations of softening are inherently met as a result of contacting the liquid and pad with the surface containing the contaminants. In reference to claim 14, refer to Fig. 13 and col. 7, lines 10-18. In reference to claim 17, refer to the Abstract. In reference to claim 18, refer to col. 8, lines 10-15.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woodford (4353145) in view of Racette et al. (5876461).

Woodford fails to teach the solvent as recited in claim 20. Woodford teaches cleaning carpets with a detergent solution. Racette et al. teach cleaning textiles using glycol ether (col. 5, line 43, col. 6, line 23) to dissolve and loosen contaminants from textile surfaces.

It would have been obvious to a person of ordinary skill in the art to have modified the method of Woodford to include the composition of Racette et al., for purposes of removing contaminants from the substrate surface.

18. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. (6260232) in view of Racette et al. (5876461).

Nelson fails to teach the solvent as recited in claim 20. Nelson teaches a

cleaning solution. Racette et al. teach cleaning textiles using glycol ether (col. 5, line 43, col. 6, line 23) to dissolve and loosen contaminants from textile surfaces.

It would have been obvious to a person of ordinary skill in the art to have modified the method of Nelson et al. to include the composition of Racette et al., for purposes of removing contaminants from the substrate surface.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bourland teaches a device for removing stains from fabrics. Wallace teaches a rug shampooing device. Lockett teaches a mop. Emrick et al. teach cleaning of textiles. Tarkinson teaches carpet cleaning. Beck teaches a composition for removing stains from fibers. Sepke et al. teach a glass cleaning device. Harris teaches cleaning of textiles. Miller teaches an hand scrub tool.

20. In several interviews with Mr. Mike King on July 30th 2004, the examiner discussed allowable subject matter. However, an agreement could not be reached.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo
Primary Examiner
Art Unit 1746

bsc

21.

SHARIDAN CARRILLO
PRIMARY EXAMINER